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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,682	12/31/2003	Brian Andrew Phillips	2043.035US2	2158

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SCHWEGMAN, LUNDBERG & WOESSNER/EBAY  
P.O. BOX 2938  
MINNEAPOLIS, MN 55402

EXAMINER
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FADOK, MARK A

ART UNIT	PAPER NUMBER
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3625

NOTIFICATION DATE	DELIVERY MODE
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12/22/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTO@SLWIP.COM  
request@slwip.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/749,682	<b>Applicant(s)</b> PHILLIPS ET AL.	
	<b>Examiner</b> MARK FADOK	<b>Art Unit</b> 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 16-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Continued Examination Under 37 CFR 1.114***

The examiner is in receipt of applicant's response to office action mailed 6/23/2009, which was received 9/23/2009. Acknowledgement is made that no amendment was provided, therefore claims 16-20 are open to prosecution. Applicant's remarks have been carefully considered and were found to be persuasive, therefore the new ground of rejection is provided below:

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rotman (US 7,324,968) in view of Lettich (US PG PUB 20020049622) and further in view of Woods (US PG PUB 20020152174) or Tsunenari (US 7076449) or Chalmers (US 7266513) or Tsunenari (US PGPUB 20020013744), or Buettgenbach (US PG PUB 20020032613) or Chalmers (US PG PUB 20020152093) or Yashiro (US PG PUB 20030033260) or Willoughby (US PG PUB 20030217017) or Yang (US PG PUB 20040153370) or Lussow (US PU PUB 20040153424).**

Art Unit: 3625

In regards to claims 16-20, Rotman teaches a shipping system that acts as a proxy for the seller and is integrated at a payment processor (Rotman, summary and col 14, lines 49-61), but does not specifically mention interacting with an on-line interface hosted by the shipping vendor. Lettich teaches an integration architecture that permits disparate supply chain members to maintain their individual status on a single hosted site. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Rotman the integration architecture of Lettich, because this permits one stop shopping and permit the parties to collaborate without losing their individual identities in the supply chain (Lettich, para 0002).

It is also noted that the combination of Rotman and Lettich does not specifically teach that a shipping label is provided via a web page. Woods teaches generating a label and transmitting it to the entity that is shipping the product (Woods, para 0013). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Rotman and Lettich sending a shipping label, because this will assure that information is consistent with the information collected from both the buyer and the sender, thus reducing errors. Applicant may argue that the label is not printed at the sender, however, this is not claimed. Further the examiner points out that Woods discloses the claimed invention except that the label is provided to the carrier. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the label sent to the sender, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Art Unit: 3625

The examiner also offers an alternate rejection to point out how ubiquitous the claimed features of providing a label through a third party to a sender that prints out the label that is provided in a web page via an interface. Applicant is directed to Tsunenari (US Patent) col 7, line 60-col 8, line 15, col 10, lines 6-14, col 11, lines 17-57, col 11, lines 46-60, col 13, lines 1-9, col 14, lines 55-63, Chalmers col 10, lines 6-24, col 11, lines 41-64, Tsunenari para 0058, 0070, 0075, 0081, 0083, 0090, or Buettgenbach, claim 25 or Chalmers para 0059, 0066, or Yashir, para 0045, 0069, or Willoughby, claim 27, or Yang para 0038, 0059, 0060, or Lussow 0071. Applicant may argue that the product in some of the cited references is a returned good. However, it is well understood in the online sales world, particularly in an auction environment where there are millions of sales by individual sellers, that products must be shipped to the buyer. Therefore, it would have been obvious to try, by one of ordinary skill in the art at the time the invention was made to send the label to the seller as it is sent to a person that is returning a product, since there are a finite number of identified, predictable potential solutions (have the seller pick up a shipping label at the carrier, have the shipping label mailed or physically delivered or providing the label over the internet) and one of ordinary skill in the art could have pursued the known potential solution with a reasonable expectation of success (it is well known the convenience of providing the label over the internet). The same rationale applies to the reasons for combining the combination of Rotman and Lettich with Woods or Tsunenari or Chalmers or Tsunenari, or Buettgenbach or Chalmers or Yashiro or Willoughby or Yang or Lussow.

***Response to Arguments***

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues that Rotman does not teach “registering the sender with the shipping vendor”, “interacting with an online interface” and “generating a web page”. The examiner disagrees and notes that the examiner understands the term register to be the passing of information to another where it is stored. Rotman teaches that the buyer registers shipping information at a host so that the information can be automatically sent to the seller/shipper (col 10, lines 16-18) and that the seller registers data using web based form (col 3, lines 10-33). Rotman further teaches that in one embodiment the system is capable of “automated fulfillment of shipping”. It would have been obvious to try, by one of ordinary skill in the art at the time of the invention to register the sender with the shipping vendor as is provided in that capabilities of Rotman, since one of ordinary skill in the art could have pursued the known potential solution of sending shipping information to a carrier to provide for automated shipping with a reasonable expectation of success.

In regards to the “interacting with an on-line interface. Rotman clearly teaches an on-line interface that provides information hosted by the shipping vendor (col 7, lines

Art Unit: 3625

15-30, rate databases are provided directly from the carrier and is provided in an on-line interface (FIG 8).

In regards to the generating of a web page, Rotman clearly teaches generating and serving web pages, see the numerous mentioning of web pages and html along with the various depictions of web pages in the provided drawing.

Applicant argues that the combination of Rotman and Lettich does not teach, “registering the sender with the shipping vendor, or interacting with an online interface” and does not relate to the claim features of receiving shipping data pertaining to the shipment from the shipping vendor...corresponding to a shipping label, nor does it describe the claim element generating and serving a web page via which the shipping label may be printed. As discussed supra, Rotman provides the capability and suggestion to register the sender with the shipping vendor and interacting with an on-line interface. The examiner is puzzled by the shipping label features that are argued in that these claim features were rejected with a combination including Woods. These features are addressed below.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the

Art Unit: 3625

references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, all the cited art pertains to selling and shipment of products on the Internet.

Applicant's arguments in regards to Woods were persuasive, however after further search and consideration the following new ground of rejection is provide above.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **571.272.6755**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Jeffrey Smith** can be reached on **571.272.6763**.

Any response to this action should be mailed to:

***Commissioner for Patents***

***P.O. Box 1450***

Alexandria, Va. 22313-1450

or faxed to:

**571-273-8300**

[Official communications; including  
After Final communications labeled  
"Box AF"]



Art Unit: 3625

For general questions the receptionist can be reached at

571.272.3600

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/Mark Fadok/

Mark Fadok

Primary Examiner, Art Unit 3625